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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,967	11/13/2003	William Christopher Duffy	US 1362/03	6772

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EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/705,967	<b>Applicant(s)</b> DUFFY, WILLIAM CHRISTOPHER	
	<b>Examiner</b> James M Hewitt	<b>Art Unit</b> 3679	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/13/03, 4/1/04 and 3/4/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/1/04, 3/4/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on 4/1/04. These drawings are acceptable.

### ***Claim Objections***

Claims 1-16 are objected to because of the following informalities:

Initially, from 37 C.F.R. 1.75(g), the least restrictive claim should be presented as claim 1. Claim 5 is clearly the least restrictive claim.

In claim 1 line 11, "sealants" should be "sealant".

In claim 1 lines 12-13, the phrase "to prevent the flow of air between the inner surface of said liner section and exterior to said duct assembly" should be replaced with "to prevent the flow of air from the inner surface of said liner section to exterior of said duct assembly" for clarity.

In claim 5 line 4, the phrase "one or more fire-resistant panels, said fire-resistant panels" should be replaced with "at least one fire-resistant panel, said at least one fire-resistant panel".

In claim 5 line 7, "therefor" should be inserted after "fasteners".

In claim 5 line 8, "at least one" should be inserted before "fire-resistant".

In claim 5 line 10, "therefor" should be inserted after "fasteners".

In claim 5 line 12, "at least one" should be inserted before "fire-resistant".

In claim 5 line 13, "at least one" should be inserted before "fire-resistant".

In claim 6 line 1, "fire-resistant" should be "fire-rated".

In claim 7 line 1, "fire-resistant" should be "fire-rated".

In claim 7 line 3, "one" should be inserted before "connector member".

In claim 8 line 1, "fire-resistant" should be "fire-rated".

In claim 8 line 2, "field installable" should be replaced with "able to be installed in the field" for clarity.

In claim 8 line 3, "associated" should be replaced with "one".

In claim 8 line 4, "field modifiable" should be replaced with "able to be modified in the field" for clarity.

In claim 9 line 7, "therefor" should be inserted after "fasteners".

In claim 9 line 10, "therefor" should be inserted after "fasteners".

In claim 9 line 14, "in" should be replaced with "at".

In claim 10 line 1, "fire-resistant" should be "fire-rated".

In claim 10 line 3, "one" should be inserted before "flange".

In claim 11 line 1, "fire-resistant" should be "fire-rated".

In claim 11 line 2, "field installable" should be replaced with "able to be installed in the field" for clarity.

In claim 11 line 3, "associated" should be replaced with "one".

In claim 11 line 4, "field modifiable" should be replaced with "able to be modified in the field" for clarity.

In claim 12 line 1, "fire-resistant" should be "fire-rated".

In claim 12 line 2, "field installable" should be replaced with "able to be installed in the field" for clarity.

In claim 12 line 3, "associated" should be replaced with "one".

In claim 12 line 4, "field modifiable" should be replaced with "able to be modified in the field" for clarity.

In claim 13 line 5, the phrase "one or more fire-resistant panels, said fire-resistant panels" should be replaced with "at least one fire-resistant panel, said at least one fire-resistant panel".

In claim 13 line 8, "therefor" should be inserted after "fasteners".

In claim 13 line 9, "at least one" should be inserted before "fire-resistant".

In claim 13 line 11, "therefor" should be inserted after "fasteners".

In claim 13 line 13, "at least one" should be inserted before "fire-resistant".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (see paragraph [0005] of Applicant's specification) in view of Sullivan (US 4,537,430).

In paragraph [0005], Applicant discloses a fire-rated duct produced by Durasystems Barriers Inc. comprising a support framework (liner section) fabricated from 1/8" steel that is welded into the required type of fitting and then clad with a fire resistant composite panel using specially tested fasteners. This duct assembly differs from the claimed invention only in that the fittings at the ends of the ducts are welded to the duct assembly instead of using removable fasteners, and in that the joints between the liner section and the fittings (flange assemblies) do not include fire-resistant sealant. Sullivan teaches a duct joining system employing end fittings or flange assemblies that are removably attached to the ducts via removable fasteners (25). In view of Sullivan's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the Durasystem welded fittings with removable fittings in order to permit easier and quicker assembly and disassembly of the ducts during repair or installation and replacement. The Examiner takes official notice of the use of fire-resistant sealant in duct joints. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ fire-resistant sealant at the joints between the liner section and the end flanges in order to enhance fire-resistance of the duct assembly.

Regarding the limitations requiring the assembly components to be pre-assembled at a factory, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, these limitations have not been given patentable weight. Refer to MPEP 2113.

Similarly, regarding the limitations requiring the connector members to be shipped separately from the duct assembly, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, these limitations have not been given patentable weight. Refer to MPEP 2113.

Regarding the recitations requiring the duct sections to form a conduit for running electrical wires, plumbing or for smoke evacuation, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 571-272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3679

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JAMES M. HEWITT**  
**PRIMARY EXAMINER**